

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/809,620	02/05/98	GOULVEN	V

MM42/0708

EXAMINER

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FRANCE

AIR MAIL

NGUYEN, T

ART UNIT	PAPER NUMBER
2872	14

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/809,620	Applicant(s) Vernois Goulven
	Examiner Thong Q. Nguyen	Group Art Unit 2872

Election
 Responsive to communication(s) filed on Apr 14, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-43 is/are pending in the application.

Of the above, claim(s) 13, 14, 18-21, and 23-41 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-12, 15-17, 22, 42, and 43 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on Feb 5, 1998 is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

An examination of this application reveals that applicant is unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.

Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

Election/Restrictions

Applicant's election of invention I, including claims 2-12, 15-17, 42/1 and 43 in Paper No. 13 of April 14, 1999 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

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As a result of applicant's election, claims 1-12, 15-17, 22, 42/1 and 43 are examined in this Office action, and claims 13-14, 18-21, 23-41, and 42/41 have been withdrawn from further consideration as being directed to non-elected invention.

It is noted that in the Paper No. 13 filed on 04/14/99, applicant has requested that claims 14 and 18 should be examined with the invention elected. See Paper No. 13, pages 2-4. ***Such a request is denied*** because the device as claimed in each of claim 14/1 and claim 18/1 is directed to a mirror and a membranae of the mirror which are grouped into another invention for the reason as set forth in the restriction requirement (Paper No. 12 of March 16, 1999).

It is also noted that in the Paper No. 13 filed on 04/14/99, applicant has suggested to amend claims 1-12, 14-18, 38 and 42-43; however, ***the mentioned claims as shown in Paper No. 13 have NOT been entered into the application*** because applicant has failed to comply with the requirements as set forth in the Manual of Patent Examination Procedure (hereinafter M.P.E.P), Chapter 600, and the requirements as set forth in the Title 37 -- Code of Federal Regulation (hereinafter 37 C.F.R.), Rules 37 C.F.R. 1.121.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on applications filed in French on Sept. 26, 1994 and June 30, 1995. It is noted, however, that applicant has not filed a certified copy of the French applications as required by 35 U.S.C. 119(b).

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Oath/Declaration

A new oath or declaration is required because the present Oath is defective for the reasons as set forth below. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

- 1) It does not identify the citizenship of each inventor; and**
- 2) It was not executed in accordance with either 37 CFR 1.66 or 1.68. In other words, the present Oath does not have a date of the executed time.**

Drawings

1. This application has been filed with drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed. Note the comments of the Office draftsperson on the attached form PTO-948.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: In particular, the numerical references "8" (figs. 1,3), "36 and 37" (fig. 4), "87" (fig. 15), "47, 73 and 75" (fig. 27), "91" (figs. 36 and 37), "67.2 and 112" (fig. 43), "118" (fig. 46), etc.... Correction is required.

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3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: In particular, the numerical references "30" (page 7), "58" (page 9), "66" (page 10), "65.8, 68 and 69" (page 11), "65 and 75" (page 12), "48" (page 13) etc... are not shown in at least one figure. Correction is required.

4. The drawings are objected to because of the following reasons: 1) In fig. 21, the use of the numerical reference "41" on the left and top side of the figure is improper. In particular, the reference "41" appeared on the left and top side of the figure should be changed to --42--; 2) In figure 30: the component labeled as "41" seems to be incorrect. Based on the structure of the components labeled as "23, 20, 42" then the tube "41" must be oriented in a direction which is perpendicular to the face of the page. The tube "41" cannot orient as shown in fig. 30; 3) The application as shown in the specification contains figure 42; however, the application does not have figure 42; Correction is required.

Specification

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.
2. Applicant is advised on how to arrange the content of the specification.

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a). The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive, preferably from two to seven words.

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- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Reference to a "Microfiche Appendix": See 37 CFR 1.96(c) and MPEP § 608.05. The total number of microfiche and the total number frames should be specified.
- (e) Background of the Invention: The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. This item may also be titled "Best Mode for Carrying Out the

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Invention." Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

- (I) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet. (37 CFR 1.52(b)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps.
- (j) Abstract of the Disclosure: A brief narrative of the disclosure as a whole in a single paragraph of 250 words or less on a separate sheet following the claims.
- (k) Drawings: See 37 CFR 1.81, 1.83-1.85, and MPEP § 608.02.
- (l) Sequence Listing: See 37 CFR 1.821-1.825.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
- (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

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© In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the present specification fails to provide an adequate written description of the invention. The present specification as filed fails to comply with the U.S. practice and comply with the regulations as set forth in 35 USC 112. The structural relationships among the components constituting the inventive device are not described in a full, clear, concise to enable one skilled in the art to which it pertains to make or use the same, and also does not set forth the best mode contemplated by the inventor of carrying out his invention. While applicant has provided a numerous alternative features concerning the components used to make his invention; however, it is unclear to one skilled in the art about the exact structure of the invention based on the information as provided in the present specification.

3. The disclosure is objected to because it contains a numerous grammatical and idiomatic errors. Some of errors are provided as follow: a) Page 1: line 23, "et" should be deleted, and each of the terms "envisage" and "hight" on line 23 contains a typo; on line 31, "Fig 21, 27" should be changed to --Fig. 27) because figure 21 does not contain any component(s) concerning the protecting membranes 67; b) Pages 3-4: the brief description of each of figures 1-56 is unclear. Applicant must provide an exact and clear brief description of each figure; c) Page 4: line 19: "(Fig. 31)" should be changed to --(Fig. 3)--; d) Page 6: line 27, "290" should be changed to

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--29--; e) Page 8: line 6, "first" should be changed to --main--; on line 13, "(fig. 24)" should be deleted or changed to suitable figure because figure 24 does not show the description thereof "Mirror 45...optical axis" (lines 11-13); f) Page 13: lines 22 and 31, the numerical reference "79" is used to refer to two different items; and on line 32, "4" should be changed to --45--; g) page 15: line 17, "Fig. 16 and 17)" should be changed to --(Figs. 36 and 37)--, and on line 32, (Fig. 19)" should be changed to --(Fig. 39)--, etc... The listed grammatical and idiomatic errors as provided above are merely those which appear in the specification. Applicant should carefully proofread the specification and make the necessary corrections. Appropriate correction is required.

4. **If applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed.**

5. ***A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.***

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Claim Objections

Claim 42 is objected to under 37 CFR 1.75© as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim 42 has not been further treated on the merits.

Claim Rejections - 35 USC § 112

1. Claims 1-12, 15-17, 22 and 43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a) The device as claimed in claim 1 is rejected under 35 USC 112, first paragraph because the specification does not teach the arrangement of the storeys as claimed. In particular, while the specification teaches that the story (5) is positioned at about equal distance from storeys (4) and (6) (see specification at page 8, for instance), the specification does not disclose that the second storey is disposed at the focal plane of the mirror and the third storey is disposed at the curvature center of the mirror as claimed.

b) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiencies thereof.

2. Claims 1-12, 15-17, 22 and 43 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph for the following reasons.

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a) Claim 1 is rejected under 35 USC 112, second paragraph for the following reasons: 1)

Each of the features “said mirror’s actuating and protecting devices” (lines 2-3), “the focal plane of the mirror” (line 4), “the image” (line 5), “the curvature center of the mirror” (lines 6-7), “the shape of the mirror” (line 7), “the object” (line 8), “the optical system” (line 9), “the membranes” (line 16), and “the actuating membrane” (line 16) lacks a proper antecedent basis; 2) the feature thereof “the mirror and its actuating device...intermediate device” (lines 13-15) is indefinite because it is unclear about the structure of the mirror and its actuating device as claimed in the mentioned feature. In other words, it is unclear about the structure of the mirror and its actuating device from the mentioned feature. Applicant should note that since an arrangement of a mirror and its actuating device tied directly to the mirror has different structure to the arrangement of a mirror and its actuating device which is tied indirectly to the mirror via an intermediate device; therefore, two different structures cannot be recited in a single claim; and 3) the feature thereof “the membranes, or only the actuating membrane...coils shape” (lines 16-19) is indefinite for the similar reasons as set forth in element a(2) above. Finally, --an-- should be used in stead of “a” appeared on each of lines 8 and 15 of the claim, and the term “characterised” should be changed to --characterized--.

b) Claim 2 is rejected under 35 USC 112, second paragraph because 1) each of the features “the optical axis” (line 2), “the means of uniting the three storeys”, and ‘the level of the mirror storey” lacks a proper antecedent basis; 2) the feature concerning the so-called “winding” (lines 1-2) is unclear. What element and its structure does applicant mean by the so-called

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“winding” here; and 3) the feature thereof “a winding centred (centered?) on...said telescope” (lines 1-5) is not understood. What does applicant intent to claim here? What kind of structure between the so-called “winding” and the mirror storey can be read from the mentioned feature?

c) Claim 3 is indefinite because the feature “the means typing the storeys” (lines 1-2) lacks a proper antecedent basis.

d) Claim 4 is indefinite because the feature “the blind cylinder” (lines 1-2) lacks a proper antecedent basis. Applicant should note that claim 3, NOT claim 1, recites a blind cylinder.

e) Claim 5 is indefinite because each of the features “the blind cylinder” (lines 1-2) and “the protecting jacket” (line 2) lacks a proper antecedent basis. Applicant should note that claim 3, NOT claim 1, recites both the mentioned features. The claim is also rejected under 35 USC 112, second paragraph because it is unclear about the structural relationships among the cylinder, the jacket and the spokes as recited in the claim. In other words, it is unclear about the structure of the blind cylinder, the jacket and the spokes so that the functions of “fold” and “scroll” can be executed.

f) Each of claims 6 and 7 is rejected under 35 USC 112, second paragraph because the features concerning the cylinder and the jacket does not have proper antecedent basis from claim 1. Applicant should note that the mentioned features are recited in claim 3, NOT claim 1.

g) Claim 8 is indefinite because each of the features “the optical axis”, “the blind cylinder”, and “the level of the mirror story” (line 3) lacks a proper antecedent basis.

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h) Claim 9 is rejected under 35 USC 112, second paragraph because 1) the feature “the means of folding” (lines 1-2) lacks a proper antecedent basis; 2) the feature thereof “the means for folding....centre (center?)” (lines 1-6) is not understood. What kind of structure between the two means claimed in the mentioned features? Furthermore, it is unclear about the component or the means having a so-called “centre” in the mentioned feature.

I) Claim 10 is indefinite because each of the features “the means for recognising (recognizing?) the shape of the mirror” (lines 1-2), “the control stage” (line 2), “the optical axis of the mirror” (line 3), and “the optical axis of the telescope” (line 4) lacks a proper antecedent basis.

j) Claim 11 is indefinite because the feature “the means for adjusting the mirror and its actuating membrane” (lines 1-2) lacks a proper antecedent basis.

k) Claim 12 is rejected under 35 USC 112, second paragraph because 1) each of the features “the means for controlling the mirror” (lines 1-2), “the generating line of the mirror” (lines 2-3), “the shape of the revolution of the mirror”, and “the optical axis” (line 5) lacks a proper antecedent basis; and 2) the feature thereof “in such a manner...vice versa” (lines 4-6) is unclear. What does applicant mean by that feature?

l) Claim 15 is rejected under 35 USC 112, second paragraph because 1) the feature “the actuating membrane” (line 2) lacks a proper antecedent basis; and 2) the feature thereof “the mirror...convex” (lines 2-4) is indefinite because it is unclear the exact shape of the mirror and the membrane.

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m) Claim 16 is rejected under 35 USC 112, second paragraph because each of the features “the means which unites the several storeys” (lines 1-2) and “the triangular base” (line 3) lacks a proper antecedent basis.

n) Claim 17 is indefinite because 1) the feature ‘the frame’ (lines 1-2) lacks a proper antecedent basis. Applicant should note that claim 16, NOT claim 1 recites a frame; 2) each of the features “the outside” (line 3), “the inside” (line 3), “the solar radiation” (line 4), and “the effect of a gas” (line 7) lacks a proper antecedent basis; and 3) the use of the term “or” in the feature thereof “a textile layer...a gas” (lines 6-7) renders the claim indefinite because it is unclear about how the layer is impregnated.

o) Claim 22 is rejected under 35 USC 112, second paragraph because 1) each of the features “the optical axis of the system” (lines 2-3) and “the level of mirror story” (line 3) lacks a proper antecedent basis; and 2) the feature concerning the accessory device as claimed on lines 1-2 is confusing with the feature concerning the accessory device recited in claim 1, lines 8-9. It is unclear whether both accessory devices are identical to each other. If it is identical then the term ‘an’ (line 1) should be changed to --said-- (or --the--). If it is not identical then the claim is rejected under 35 USC 112, first paragraph because the specification does not disclose two accessory devices.

p) Claim 43 is rejected under 35 USC 112, second paragraph because each of the features “the envelop” (lines 1-2), “the jacket” (line 2), “the upper cylindrical element” (lines 2-3), and “the lower cylindrical element” (lines 4-5) lacks a proper antecedent basis.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 22, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as described at page 1 of the present specification in view of either the UK reference No. 2 247 323 or the SU reference No. 1615 655.

The prior art as described at page 1 of the present specification disclose a telescope comprises three storeys which arrangements and functions of each storey are similar to those claimed in present claim 1. While the present specification does not disclose any information concerning the structure of the mirror element disposed on the mirror story of this prior art; however, the use of a reflecting element having a reflecting membranae and its actuating membrance concentrically attached therein, and actuating components in the formed of electrodes and integrated circuits are clearly known to one skilled in the art as can be seen in the telescopic mirror provided by either the UK reference '323 or the SU reference '655. With regard to the use of an illuminating system on the mirror storey as recited in claim 22, such a feature is well known to one skilled in the art in the process of use an optical system having a Cassegrain mirror system for the purpose of illuminating an object such as a star or receiving light from an object. Thus, it

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would have been obvious to one skilled in the art at the time the invention was made to modify the telescope having three storeys as provided by the prior art by using a mirror having its actuating membrane concentrically attached therein with electrodes and circuits as suggested by either the reference '323 or the reference '655 for the purpose of controlling the shape of the mirror with more accurately.

With regard to the features recited in each of present claims 2-12, 15-17, and 43, since the features concerning the structure as well as the operating of the so-called folding and supporting of the system are so incomprehensible and/or indefinite as to preclude a reasonable search of the prior art by the Examiner for the device as claimed in present claims 2-12, 15-17 and 43 (see also the rejections of claims under 35 USC 112 as set forth in this office action), and thus the device as claimed in present claims 2-12, 15-17 and 43 is not examined with respect to the prior art. Applicant should amend the claims to comply with the Rule 35 USC 112, and then the inventive device is able to an examination to see whether the instant invention is known to one skilled in the arts or not.

Conclusion

1. The additional references are cited as of interest in that each discloses a telescope having mirrored elements and mechanical systems for supporting the mirrored elements.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exam. Nguyen whose telephone number is (703) 308-4814. The fax phone

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number for the organization where this application or proceeding is assigned is (703) 308-7722 (or 7724).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Nguyen

07/05/99

A handwritten signature in black ink, appearing to read "Thong Nguyen".

Thong Nguyen
Primary Examiner